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EXAMINER

TRAN, MY CHAU T

ART UNIT

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2629

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/553,986	Applicant(s) SUGA, MASANAO	
	Examiner MY-CHAU T. TRAN	Art Unit 2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Application and Claims Status

1. Applicant's amendment and response filed 04/16/2009 are acknowledged and entered.
2. Claims 1-6 were pending. Applicants have amended claim 1. No claims were added and/or cancelled. Therefore, claims 1-6 are currently pending and are under consideration in this Office Action.

Priority

3. Applicant is reminded that the instant application is a 371 of PCT/JP04/05820 filed on 04/22/2004, and as a result this instant application has the effective filing date of 04/22/2004.

Status of Claim(s) Objection(s) and /or Rejection(s)

4. The objection to the abstract of the disclosure has been withdrawn in light of applicant's amendments of the abstract thereto.
5. The rejections of claim 1 under 35 USC 112, second paragraph of **a.** to **c.**, as being indefinite have been withdrawn in light of applicant's amendments of claim 1 thereto.

Maintained Rejection(s)

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 2-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

d. The term ‘*member*’ of claims 2-6 is vague and indefinite because it is unclear as to the metes and bound of the term. That is it is unclear whether the term ‘*member*’ is referring to a structural feature such as a register, transistor, or a jump-condition circuit, a memory storage device such as a ROM or EPPROM, an image data such as a numerical or alphanumeric character, or an abstract ideas such as an algorithm and/or data structures of a software code. The instant specification of define the term ‘*member*’ as a process/programming step, i.e. an algorithm and/or data structures of a software code, and a storage member, i.e. a memory storage device, (see specification pgs. 7-8; fig. 2). As a result, the term ‘*member*’ of claims 2-6 is vague and indefinite, and claims 2-6 are rejected under 35 U.S.C. 112, second paragraph.

Response to Arguments

8. Applicant’s arguments directed to the above 112, second paragraph, rejection were considered but they are not persuasive for the following reasons. Please note that the above rejection has been modified from it original version to more clearly address applicant’s newly amended and/or added claims and/or arguments.

[1] Applicant alleges that the term ‘*member*’ of claims 2-6 should invoke 35 U.S.C. 112, sixth paragraph. That is “*This limitations has to be construed at least under section 112, sixth*

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paragraph” and that “one skilled in the art will understand that the structural feature (the member) is used to implement the method step referred to and not the method step itself”.

This is not found persuasive for the following reasons:

[1] The examiner respectfully disagrees. It is the examiner’s position that the term ‘member’ of claims 2-6 does not invoke 35 U.S.C. 112, sixth paragraph, but rather that it is vague and indefinite. First, the limitations of claims 2-6 reciting the term ‘member’ does not invoke 35 U.S.C. 112, sixth paragraph, since it fail the first prong of the 3-prong analysis for a claim limitation that would invoke 35 U.S.C. 112, sixth paragraph, i.e. *‘the claim limitations must use the phrase “means for” or “step for”’*. See MPEP § 2181(I). Second, there is no statement in the rejection that the claim limitation is being treated under 35 U.S.C. 112, sixth paragraph. Third, assuming *arguendo* that the limitations of claims 2-6 reciting the term ‘member’ does invoke 35 U.S.C. 112, sixth paragraph, the original specification does not define in specific terms the corresponding structure, material or acts that would perform the claimed functions of the term ‘member’ in claims 2-6. Here, the original specification only provided a broad generic description the corresponding structure, material or acts that would perform the claimed functions of the term ‘member’ in claims 2-6. That is the term ‘member’ would encompass the definition of a memory storage device such as a ROM or EPROM (i.e. a storage member) or an algorithm and/or data structures of a software code (see specification pgs. 7-8; fig. 2). Thus, the term ‘member’ of claims 2-6 is vague and indefinite and does not invoke 35 U.S.C. 112, sixth paragraph.

Therefore, the rejection under 35 U.S.C. 112, second paragraph, of claims 2-6 is proper, and the rejection is maintained.

Claim Rejections - 35 USC § 102

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Watanabe et al. (US Patent 4,476,541).

For ***claim 1***, Watanabe et al. disclose an electronic calculator (see e.g. Abstract; col. 1, lines 59-68; col. 2, lines 47-55). As illustrated by figure 1, the calculator (refers to instant claimed numeral value display system) comprises a control section (ref. #2) (refers to instant claimed display processing unit) with a ROM (ref. #2A) (refers to instant claimed storage member), key input section (ref. #1) (refers to instant claimed operation key), and a display section (ref. #8) (refers to instant claimed numeral value display device) (see e.g. col. 4, lines 6-58).

The language of ‘*wherein if*’ in the amended claim 1 regarding the functional limitations of the instant claimed display processing unit (i.e. ‘*a digit number of the numeral value to be displayed is larger than a displayable digit number of the numeral value display device, the display processing unit subdivides the numeral value into a preset digit number such that the display can be understood by an operator and to display a portion of the subdivided numeral values*’) suggest or makes optional but does not require that the instant claimed display processing unit perform the function of the instant claimed functional limitation. See MPEP § 2111.04. As a result, this limitation does not limit the scope of the instant claimed device, i.e. it is interpreted that this limitation is not included as a structural feature of the instant claimed display processing unit and the instant claimed numeral value display system. And, the device of

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Watanabe et al. would still anticipate the instant claimed device since the device of Watanabe et al. meet all the structural limitations of the instant claimed device, i.e. a display processing unit, a storage member, an operation key, and a numeral value display device of instant claim 1.

Therefore, the device of Watanabe et al. does anticipate the instant claimed invention.

Response to Arguments

11. Applicant's arguments directed to the above 102(b) rejection were considered but they are not persuasive for the following reasons. Please note that the above rejection has been modified from its original version to more clearly address applicant's newly amended and/or added claims and/or arguments.

[1] Applicant contends that the rejection is based on the prior art of Boone et al., i.e. "*The correct patent corresponding to US 4,476,541 is Boone et al.*"

[2] Applicant asserts that the amendment of claim 1 "*clearly and positively recite the corresponding limitation as a structural feature of the display processing unit*".

This is not found persuasive for the following reasons:

[1] The examiner respectfully disagrees. It is the examiner's position that the above rejection is based on the prior art of Watanabe et al. As clearly stated in the rejection, the prior art used in this rejection is Watanabe et al. and the cited passages found in the body of the rejection are direct to the prior art of Watanabe et al. Hence, applicant's contention is perplexing. Moreover, applicant's arguments do not rise to the level of factual evidence. See MPEP § 716.01(c): The arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). Accordingly, the rejection is proper and is based on the prior art of Watanabe et al.

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[2] The examiner respectfully disagrees. It is the examiner's position that the amendment claim 1 does not '*clearly and positively recite the corresponding limitation as a structural feature of the display processing unit*' as asserted by applicant. The language of the limitation, i.e. '*wherein if*', suggest or makes optional but does not require or limit the structural feature of the instant claimed display processing unit. See MPEP § 2111.04. Consequently, the amendment of claim 1 does not limit the structural feature of the instant claimed display processing unit and the scope of the instant claimed device, i.e. the instant claimed numeral value display system.

Therefore, the teachings of Watanabe et al. do anticipate the device of the instant claims, and the rejection is maintained.

New Rejection(s) – Necessitated by Amendment

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. (US Patent 4,476,541).

For ***claim 1***, Watanabe et al. disclose an electronic calculator (see e.g. Abstract; col. 1, lines 59-68; col. 2, lines 47-55). As illustrated by figure 1, the calculator (refers to instant claimed numeral value display system) comprises a control section (ref. #2) (refers to instant

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claimed display processing unit) with a ROM (ref. #2A) (refers to instant claimed storage member), key input section (ref. #1) (refers to instant claimed operation key), and a display section (ref. #8) (refers to instant claimed numeral value display device) (see e.g. col. 4, lines 6-58).

The teachings of Watanabe et al. differ from the presently claimed invention as follows:

For **claims 1-6**, Watanabe et al. fail to disclose the claimed functional limitations, i.e. the type of programming algorithm, as claimed in instant claims 1-6 regarding the instant claimed display processing unit. This interpretation is base on applicant's argument regarding the term 'member', see pg. 6 of applicant's response filed 04/16/2009.

However, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to disclose the claimed functional limitations, i.e. the type of programming algorithm, as claimed in instant claims 1-6 regarding the instant claimed display processing unit in the device of Watanabe et al. One of ordinary skill in the art would have been motivated to disclose the claimed functional limitations, i.e. the type of. programming algorithm, as claimed in instant claims 1-6 regarding the instant claimed display processing unit in the device of Watanabe et al. for the type of programming algorithm would be a design choice and is considered within the purview of the cited prior art. Furthermore, one of ordinary skill in the art would have a reasonable expectation of success in including the programming algorithm as claimed in instant claims 1-6 in the device of Watanabe et al. because Watanabe et al. disclose that the device include programming algorithm (see e.g. figs. 4, 5, and 13-17).

For **claims 2-6**, Watanabe et al. fail to disclose the type of operational key as claimed in instant claim 2-6.

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However, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to disclose the type of operational key as claimed in instant claim 2-6 in the device of Watanabe et al. One of ordinary skill in the art would have been motivated to disclose the type of operational key as claimed in instant claim 2-6 in the device of Watanabe et al. for the type of operational key would be a design choice and is considered within the purview of the cited prior art. Furthermore, one of ordinary skill in the art would have a reasonable expectation of success in including the type of operational key as claimed in instant claim 2-6 in the device of Watanabe et al. because Watanabe et al. disclose that the device include various different type of functional key (see e.g. figs. 1, 7, and 18).

Therefore, the teachings of Watanabe et al. do render the device instant claims *prima facie* obvious.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MY-CHAU T. TRAN whose telephone number is (571)272-0810. The examiner can normally be reached on Monday: 8:00-2:30; Tuesday-Thursday: 7:30-5:00; Friday: 8:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard A. Hjerpe can be reached on 571-272-7691. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MY-CHAU T. TRAN/
Primary Examiner, Art Unit 2629

June 29, 2009